

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3SHAPE A/S and 3SHAPE INC.,
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner.

Case IPR2019-00154, Patent 8,363,228 B2
Case IPR2019-00157, Patent 8,363,228 B2¹

Before BRIAN J. MCNAMARA, NEIL T. POWELL, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties may not use this style caption for any subsequent papers without prior Board authorization.

IPR2019-00154, Patent 8,363,228 B2
IPR2019-00157, Patent 8,363,228 B2

On June 5, 2019, in IPR2019-00154, we instituted trial on claims 1–26 of U.S. Patent No. 8,363,228 B2 (Ex. 1001, “the 228 patent”), and in IPR2019-00157, we instituted trial on claims 1–7 and 26 of the ’228 patent. IPR2019-00154, Paper 9; IPR2019-00157, Paper 9. On February 7, 2020, Align Technology, Inc. (“Patent Owner”) filed Patent Owner’s Unopposed Motion for Adverse Judgment in each proceeding. IPR2019-00154, Paper 23; IPR2019-00157, Paper 26.

Patent Owner states that it filed U.S. Reissue Application No. 16/784,493, which cancelled claims 1–26 of the ’228 patent. IPR2019-00154, Paper 23.

In IPR2019-00154, Patent Owner requests that the Board acknowledge the cancellation of claims 1–26 and enter adverse judgment under 37 C.F.R. § 42.73(b). *Id.* Patent Owner further requests that, because claims 1–26 are the only claims at issue in IPR2019-00154, we terminate the *inter partes* review. *Id.*

In IPR2019-00157, Patent Owner requests that the Board acknowledge the cancellation of claims 1–7 and 26 and enter adverse judgment under 37 C.F.R. § 42.73(b). IPR2019-00157, Paper 26. Patent Owner further requests that, because claims 1–7 and 26 are the only claims at issue in IPR2019-00157, we terminate the *inter partes* review. *Id.*

A party may request entry for adverse judgment against itself at any time during a proceeding. 37 C.F.R. § 42.73(b). Actions construed to be a request for adverse judgment include cancellation of patent claims, such that a party has no remaining claim in the trial. *Id.* § 42.73(b)(2).

Patent Owner’s request for cancellation of claims 1–26 of the ’228 patent leaves no claim remaining for trial in either IPR2019-00154 or

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IPR2019-00157. Accordingly, entry of judgment adverse to Patent Owner pursuant to 37 C.F.R. § 42.73(b) is appropriate.

Accordingly, it is

ORDERED that Patent Owner's request for adverse judgment is *granted*;

FURTHER ORDERED that claims 1–26 of U.S. Patent No. 8,363,228 B2 are *cancelled*;

FURTHER ORDERED that, in IPR2019-00154, judgment is entered adverse to Patent Owner with respect to claims 1–26 of U.S. Patent No. 8,363,228 B2;

FURTHER ORDERED that, in IPR2019-00157, judgment is entered adverse to Patent Owner with respect to claims 1–7 and 26 of U.S. Patent No. 8,363,228 B2;

FURTHER ORDERED that these *inter partes* reviews are terminated.

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IPR2019-00157, Patent 8,363,228 B2

FOR PETITIONER:

Todd R. Walters
Roger H. Lee
Andrew R. Cheslock
Mythili Markowski
Stephany G. Small
todd.walters@bipc.com
roger.lee@bipc.com
andrew.cheslock@bipc.com
mythili.markowski@bipc.com
stephany.small@bipc.com

FOR PATENT OWNER:

Robert G. Sterne
Jason D. Eisenberg
Salvador M. Bezos
Jon E. Wright
George Howarah
Jay Bird
Sean Flood
Christopher O'Brien
rsterne-PTAB@sternekessler.com
jasone-PTAB@sternekessler.com
sbezos-PTAB@sternekessler.com
jwright-PTAB@sternekessler.com
ghowarah-PTAB@sternekessler.com
jbird-ptab@sternekessler.com
sflood-ptab@sternekessler.com
cobrien-ptab@sternekessler.com